

## **REMARKS/ARGUMENTS**

The Applicant has reviewed and considered the final Office Action mailed on February 5, 2007, and the references cited therewith.

Claims 1-10 are currently pending in the application.

### ***Request for Withdrawal of Finality of Office Action***

Before responding to the rejections of the current Office Action, Applicant submits that the entry of the current Office Action as Final was improper, and Applicant respectfully requests that the Primary Examiner withdraw the finality of the Office Action. While the Examiner continues to rely upon Svedman to reject Claim 1 under 35 U.S.C. §102, the Examiner's position in the current Office Action is markedly different from that in the previous Office Action. In the previous Office Action, the Examiner suggested, without specifically citing any supporting disclosure in Svedman, that the "sensing device 16 is a capacitive sensor that is capable of sensing compositional characteristics of unfiltered fluid from a wound bed." In the current Office Action, the Examiner now states that Svedman teaches temperature sensors, which are allegedly analogous to a fluid compositional sensing device. The Examiner proffers an inherency argument to support this analogy.

The Examiner suggests that the new rejection is simply a restatement of the rejection from the previous Office Action and excuses the new rejection by stating that Applicant's claims did not mention a specific type of sensor. In fact, the Examiner agrees with Applicant's response to the previous Office Action, in which Applicant points out that a "capacitive sensor" is not taught by Svedman.<sup>1</sup> In view of the Examiner's agreement with the Applicant's position, the current Office Action should not have been made Final. Applicant responded to the rejection presented in the previous Office Action, and the Examiner agreed that one of the elements relied upon in the previous Office Action was not actually taught by the relied-upon reference. The rejection should have been withdrawn. If the Examiner believed that the rejection needed to be restated

based on material that was not presented in the previous Office Action (i.e. that Svedman teaches temperature sensors which allegedly are inherently able to sense the compositional characteristic of a fluid), then a new rejection using the same reference (i.e. Svedman) should have been made in another non-final Office Action.

The MPEP provides that a second rejection should be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c). *MPEP 706.07(a)*. Applicant made no amendments to the claims, but simply responded to the previous Office Action by illustrating that not all of the elements of the claims were present in the cited reference. The Examiner agreed with Applicant's argument, yet "restated" the rejection using a different approach that was not previously presented to Applicant. Here, the Examiner clearly is presenting a new ground of rejection that is based on information not earlier made available to the Applicant, nor to which Applicant has had an opportunity to respond. Accordingly, Applicant respectfully requests that the Primary Examiner withdraw the finality of the rejection of the current Office Action.

### ***Claim Rejections – 35 U.S.C. § 102***

Claim 1 stands rejected under 35 U.S.C. § 102(a) as being anticipated by Svedman (U.S. Patent No. 4,382,441). The Applicant traverses this rejection and respectfully requests reconsideration in view of the following remarks.

Independent claims 1 is allowable because Svedman does not teach or suggest all of the claimed limitations. Among other things, Svedman does not teach or suggest a negative pressure therapy device that comprises "a fluid compositional sensing device."

The "restated" rejection of claim 1 again alleges that sensor 16 of Svedman is a fluid compositional sensing device, but this time bases the allegation on the temperature

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<sup>1</sup> In response to Applicant's argument regarding the absence of a "capacitive sensor" in Svedman, the Examiner states "[t]his is correct, however since a specific sensor was not claimed Examiner has restated the rejection to omit this statement." Note that a "capacitive sensor" is not a stated limitation of Claim 1.

sensing feature described in Svedman. Again, this is incorrect. Nowhere does Svedman explicitly teach or suggest that a temperature sensor is a fluid compositional sensing device. The Office Action appears to concede that there is no such explicit teaching or suggestion. Instead, the Office action "interpret[s]" temperature as "a fluid compositional characteristic in that a temperature increase signals the presence of bacterial infection." Office Action at 3. Thus, the rejection of claim 1 is based on the premise that Svedman inherently discloses a fluid compositional sensing device.

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Oelrich, 666 F.2d 578, 581 (C.C.P.A. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939)). A reference must teach or suggest that the missing feature is necessarily present. Toro Co. v. Deere & Co., 355 F.3d 1313, 1321 (Fed. Cir. 2004).

Svedman simply does not teach or suggest that a temperature increase necessarily signals the presence of bacterial infection. To the contrary, Svedman teaches that heat may be applied to a fluid to therapeutically temper tissue, and that an increase in temperature merely indicates a possibility that too much heat is applied for a desired treatment, without regard to the composition of the fluid. The temperature sensor of Svedman is used only to regulate the application of heat to the fluid. Thus, the temperature sensor described by Svedman is not a fluid compositional sensing device, as the Office Action concludes.

Accordingly, the rejection of claim 1 and its dependents is clearly in error, and the Applicant respectfully requests that the Examiner withdraw the rejection. Independent claim 6 and its dependents should also be allowed because Svedman fails to teach or suggest the fluid compositional sensing device.

Although the Applicant has pointed out specific differences between the claimed invention and the cited references that illustrate the error in the rejection, such differences are not necessarily exhaustive and the Applicant reserves the right to raise additional issues as needed upon further action by the Examiner.

***Claim Rejections – 35 U.S.C. § 103***

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman ('441) in view of Overton ('846). Claim 4 is rejected over Svedman ('441) in view of Lewis et al ('440). Claims 5, 6 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman ('441) in view of Henley et al ('109). Claim 7 is rejected as unpatentable over Svedman in view of Henley and Scherson ('570). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman ('441) in view of Henley et al ('109), as applied to claims 5, 6 and 10 above, and further in view of Fleischmann ('767). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman ('441) in view of Henley et al ('109), as applied to claims 5, 6 and 10 above, and further in view of Parker, et al ('391).

In view of the Office Action's erroneous application of Svedman, discussed above, the rejection of claims 2-10 under 35 U.S.C. § 103 is moot. Again, however, the Applicant respectfully reminds the Examiner of the duty to support an alleged suggestion or motivation to modify the teaching of the prior art with particular findings and substantial evidence. In re Kotzab, 217 F.3d 1365, 1370 & 1371 (Fed. Cir. 2000). The broad, conclusory statement of suggestion or motivation offered by the Office Action are insufficient to meet the Examiner's burden for establishing a prima facie case of obviousness under § 103. Id. at 1370. Accordingly, the Applicant again respectfully requests that the Examiner withdraw the rejection of claims 2-10 under 35 U.S.C. § 103.

### CONCLUSION

If a Petition for Extension of Time under 37 C.F.R. 1.136(a) or an additional Petition for Extension of Time under 37 C.F.R. 1.136(a) is required, the petition is herewith made. The Commissioner is authorized to charge any fees that may be required, or credit any overpayment made with this Office Action, to Deposit Account Number 50-0326.

In light of all the foregoing, believing that all things raised in Examiner's final Office Action have been addressed, Applicant respectfully requests a notice of allowance and passage of the application to issue. If the Examiner would care to discuss any remaining matters by phone, Applicant invites the Examiner to contact Robert W. Mason at 210.255.6271.

Respectfully submitted,



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